

Applicant : Riccardo Dalla Favera  
Serial No.: 09/724,254  
Filed : November 28, 2000  
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In view of the remarks below, applicant maintains that the Examiner's rejection has been overcome, and respectfully requests that it be withdrawn.

**Rejection Under 35 U.S.C. §102(e)**

The Examiner maintained the rejection of claims 43, 45-47, 69 and 70 under 35 U.S.C. §102(e), as allegedly anticipated by Ashkenazi et al., U.S. Application Publication No. 2002/0132252 A1, filed November 14, 2001.

In response, applicant again respectfully traverses the Examiner's rejection. Applicant continues to maintain that Ashkenazi et al. is not a proper 102(e) reference and as such cannot be used to reject pending claims 43, 45-47, 69 and 70.

In the previous December 1, 2004 office action, the Examiner stated that the "changes made to 35 U.S.C. §102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. Patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore the prior art date of the reference is determined under U.S.C. 102(e) prior to the amendment by the AIPA."

Former 35 U.S.C. §102(e) states that "[a] person shall be entitled to a patent unless \*\*\*\*\* (e) the invention was

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described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent."

In the June 6, 2005 Final Office Action, the Examiner maintained the rejection under 35 U.S.C. §102(e) stating that none of the applications to which Ashkenazi et al. claims benefit are international applications, and therefore the Examiner alleges that applicant's argument that Ashkenazi et al. has an effective 102(e) date of November 4, 2001, as set forth in the March 1, 2005 Communication In Response To December 1, 2004 Office Action, is not persuasive.

In response, applicant respectfully points the Examiner's attention to M.P.E.P §706.02(f)(1), Examination Guidelines for Applying References Under 35 U.S.C. §102(e), which states:

"(A) The potential reference must be a U.S. patent, a U.S. application publication (35 U.S.S. 122(b)) or a WIPO publication of an international application under PCT Article 21(2) in order to apply the reference under 35 U.S.C. 102(e)."

Applicant notes that Ashkenazi et al. is a U.S. application publication (35 U.S.C. 122(b)). M.P.E.P §706.02(f)(1) further

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states:

"(B) Determine if the potential reference resulted from, or claimed the benefit of, an international application. If the reference does, go to step (C)".

Applicant notes that Ashkenazi et al. claims the benefit of 43 different international applications, as listed on pages 1 and 2 of the patent application publication.

Step (C) of M.P.E.P. §706.02(f)(1) then states:

"(C) If the potential reference resulted from, or claimed the benefit of, an international application, the following must be determined:

(1) If the international application meets the following three conditions:

(a) an international filing date on or after November 29, 2000;

(b) designated the United States; and

(c) published under PCT Article 21(2) in English, then the international filing date is a U.S. filing date for the purposes under 35 U.S.C. 102(e)." (emphasis added)

However, step (C) of M.P.E.P §706.02(f)(1) further states:

"(3) If the international application has an international filing date prior to November 29, 2000, apply the reference

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under the provisions of 35 U.S.C. 102 and 374, prior to the AIPA amendments:

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(c) For U.S. application publications of applications that claim the benefit under 35 U.S.C. 120 or 365(c) of an international application filed prior to November 29, 2000, apply the reference under 35 U.S.C. 102(e) as of the actual filing date of the later-filed U.S. application which claimed the benefit of the international application."

Applicant notes that, for example, the first cited international application on page 1 of the patent application publication is PCT/US97/20069 which was filed on November 5, 1997, an international filing date not on or after November 29, 2000. Accordingly, these three criteria of section (C)(1)(a)-(c) are not met by Ashkenazi et al.

Instead, the provisions of §102(e), prior to the AIPA amendments, are to be applied here.

Accordingly, applicant continues to maintain that the 102(e) date of Ashkenazi et al. is November 14, 2001, the actual filing date of the later filed U.S. application which claimed the benefit of the international application. Therefore applicant again maintains that Ashkenazi et al. cannot properly be used as

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a 102(e) prior art reference against the pending claims of the subject application filed November 28, 2000 and claiming the benefit of U.S. Provisional Application No. 60/168,151, filed November 29, 1999. Applicant further notes that the numerous §119 and §120 benefit claims of Ashkenazi et al. do not negate the applicability of the provisions of 102(e) as they existed prior to the AIPA amendments.

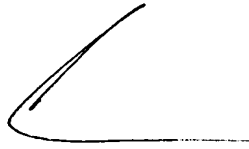
For the reasons set forth hereinabove, applicant respectfully requests that the Examiner reconsider and withdraw the rejection, and solicits allowance of the pending claims.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicant's undersigned attorneys invite the Examiner to telephone them at the number provided below.

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No fee is deemed necessary in connection with the filing of this Communication. However if any fee is required, authorization is hereby given to charge the amount of such fee to Deposit Account No. 03-3125.

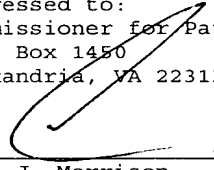
Respectfully submitted,



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8/8/01  
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